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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,010	12/17/2001	Barrie Alan Hadfield	7484-0003 (6611/54260)	2464

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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/023,010	Applicant(s) HADFIELD ET AL.	
	Examiner Doug Hutton	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-62 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 48, 54-56 and 60-62, drawn to a method for granting "version control" to a managing author in a document collaboration system that comprises Inventions II, III and IV, classified in Class 715, Subclass 511.
- II. Claims 1-15, drawn to a method for granting "editing rights" to a contributing author for an original document, classified in Class 707, Subclass 9.
- III. Claims 16-26 and 30-35, drawn to a method for creating a "difference file" from an "edited replica" of an original document, classified in Class 715, Subclass 531.
- IV. Claims 27-29, drawn to a method for allowing a contributing author to edit an original document and email said edited document to a managing author, classified in Class 715, Subclass 752.
- V. Claims 40-47, 49-53 and 57-59, drawn to a method for allowing a managing author to select which of the contributing author's suggested amendments for an original document are incorporated into said document, classified in Class 715, Subclass 511.

Inventions I and II are related as combination (Invention I) and subcombination (Invention II). Inventions in this relationship are distinct if it can be shown that: (1) the combination as claimed does not require the particulars of the subcombination as

claimed for patentability; and (2) the subcombination has utility by itself or in other combinations (MPEP §806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not set forth the details of the subcombination as claimed, and the subcombination has utility by itself. The subcombination has utility by itself in that Invention II may be used to allow a managing author to grant "editing rights" to a contributing author for an original document, without creating a "difference file" from an "edited replica" of said document (Invention III), allowing a contributing author to edit said document and email said edited document to a managing author (Invention IV) and/or allowing the managing author to subsequently approve the contributing author's suggested amendments before incorporating said amendments into said document (Invention V).

Inventions I and III are related as combination (Invention I) and subcombination (Invention III).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not set forth the details of the subcombination as claimed, and the subcombination has utility by itself. The subcombination has utility by itself in that Invention III may be used to create a "difference file" to clearly illustrate a contributing author's suggested amendments for an original document, without allowing a managing author to grant "editing rights" to a contributing author before said contributing author makes suggested amendments to

said document (Invention II), allowing a contributing author to edit said document and email said edited document to a managing author (Invention IV) and/or allowing the managing author to subsequently approve the contributing author's suggested amendments before incorporating said amendments into said document (Invention V).

Inventions I and IV are related as combination (Invention I) and subcombination (Invention IV).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not set forth the details of the subcombination as claimed, and the subcombination has utility by itself. The subcombination has utility by itself in that Invention IV may be used to allow a contributing author to edit an original document and email said edited document to a managing author, without allowing a managing author to grant "editing rights" to a contributing author before said contributing author makes suggested amendments to said document (Invention II), creating a "difference file" from an "edited replica" of said document (Invention III) and/or allowing the managing author to subsequently approve the contributing author's suggested amendments before incorporating said amendments into said document (Invention V).

Inventions I and V are related as combination (Invention I) and subcombination (Invention V).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not set forth the details of the subcombination as claimed, and the subcombination has utility by itself. The subcombination has utility by itself in that Invention IV may be used to allow a managing author to select which of the contributing author's suggested amendments for an original document are incorporated into said document, without allowing a managing author to grant "editing rights" to a contributing author before said contributing author makes suggested amendments to said document (Invention II), creating a "difference file" from an "edited replica" of said document (Invention III) and/or allowing a contributing author to edit said document and email said edited document to a managing author (Invention IV).

Finally, Inventions II, III, IV and V are related as disclosed in the specification of the present invention. However, these inventions are patentably distinct because each invention includes limitations not found in the other inventions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. Moreover, because the searches required for each individual group is not required for the other groups, restriction for examination purposes as indicated is proper.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
February 10, 2005

A handwritten signature in black ink, appearing to read 'D. Hutton', with a stylized flourish at the end.

**DOUG HUTTON
PATENT EXAMINER
TECH CENTER 2100**